

### **REMARKS**

Claims 1-41 were previously pending, of which claim 2 has been cancelled, and claims 1, 10, 25, and 37-38 have been amended. Reconsideration of presently pending claims 1 and 3-41 is respectfully requested in light of the above amendments and the following remarks.

#### **Declaration Objections**

The Examiner has objected to Thierry Bieler's Switzerland address provided in the declaration. A supplemental application data sheet is being provided herewith to address this objection.

#### **Drawing Objections**

The drawings stand objected to for failing to show a "rectangle shaped conductive element." The drawings show a "substantially rectangular shaped conductive element at the photographs of Figs. 5a and 5b, and the claims have been amended accordingly.

#### **Specification Objections**

Reference to a collective reference for Figures 4a, 4b, and 4c (collectively Figure 4) and Figures 5a and 5b (collectively Figure 5) have been added to avoid any ambiguity.

The title of the invention has been amended to be consistent with an embodiment of the invention.

#### **Claim Objections**

Claims 2, 7, 8, 9, 23 and 24 are objected to for formalities. Claim 2 has been cancelled. As for the term "self supporting", this term has its ordinary meaning. Webster's Dictionary defines "self supporting" as "supporting itself." The specification further provides specific examples of "self supporting" windings at paragraph [0036]. Paragraph [0036] and Figures 4a – 4b and 5a-5b further described an embodiment of a self-supporting winding referred to by the applicant as a "self-supporting winding A".

### **Claim Rejections**

Claims 1, 5-9, 12-15, 22-24, 27-30 and 37-40 were rejected under 35 U.S.C. §102(b) as being anticipated by Dunlop, et al. (PCT Publication No. WO 93/26705 hereinafter referred to as "Dunlop"). This rejection is respectfully traversed.

Claims 7, 22, and 37 each require a "self-supporting winding." Dunlop does not describe a self-supporting winding. Instead, Dunlop's winding 12 is "a slotless, non-skewed, two pole winding having three phase windings." pg. 4, line 18. Furthermore, claim 37 requires that the winding be "electrically connected to an electrical supply at only one end of the winding". Dunlop's winding 12 is connected at both ends. ("It is apparent from Fig. 1 that, the winding 12 not only extends along the length of the rotor body 17, but has ends 28 that overlap from the rotor body 17 onto the shaft portions 29, 30 of the rotor ends 15 and 16 to enclose the body 17." Dunlop pg. 4, lines 22-25.)

Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Dunlop and Shirakawa (US Patent No. 5,140,210 hereinafter referred to as "Shirakawa"). This rejection is respectfully traversed.

Independent claim 1 has been amended to include the limitations of original claim 2 (claim 2 has since been cancelled). Claim 1 requires a "protective layer disposed between the stator and the rotor." In contrast, Shirakawa describes a cup-shaped support member 44 that is outside of the stator magnets 33, and is not disposed between the stator and the rotor. col. 2, lines 46-50. Since this limitation is missing altogether, there can be no infringement under 103.

Additional claims stand rejected under 35 U.S.C. §103(a) as being unpatentable over Dunlop and Vaerenbergh ("Ageing of Permanent Magnet Devices at ESRF,"), Dunlop and Ozawa, et al. (European Patent No. 1 073 179), Dunlop and Sawada, et al. (US Patent No. 6,133,667), Dunlop and Perkins (US Patent No. 6,208,056), Dunlop and Wallner (US Patent No.

6,107,704 ), Dunlop and Lou, et al. (US Patent No. 5,990,584). For each of the above-listed combinations, the Examiner has failed to meet his burden in showing a motivation to combine the references. As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness. Instead, the Examiner has attempted to combine various references only after recognition of the problem by the applicant. § 2142 of the MPEP also provides:

*...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

In this context, the MPEP further provides at § 2143.01:

*The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

Thus applicant requests the withdrawal of all the stated rejections under 35 U.S.C. §103.

**Conclusion**

It is clear from all of the foregoing that independent claims 1 and 3-41 are in condition for allowance. An early formal notice of allowance is requested.

Respectfully submitted,



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